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EXAMINER

MACASIANO, MARILYN G

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,237	<b>Applicant(s)</b> PANARA, TIZIANO	
	<b>Examiner</b> MARILYN MACASIANO	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,12-15 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12-15 and 18-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

1. This is in response to the amendment filed on May 13, 2010. Claims 1, 4, 8, 12, 13 and 25 are amended. Therefore, claims 1-6, 8-10, 12-15 and 18-27 are currently pending and are considered below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-10, 12-15 and 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al. (U.S. Patent No. 5,913,040) (hereinafter 'Rakavy').

Claims 1, 4 and 8: Rakavy discloses a computer-based method of delivering auxiliary content comprising the steps of:

receiving over a network a request from a client terminal for an item of the auxiliary content, each item of the auxiliary content having an associated broadcast space comprising a respective time slot (col. 3, lines 4-43 and col. 7-8, lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col. 15, lines 28-42, fig. 10) the time slot associated with each said auxiliary content item defining a time

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frame for the delivery of the associated auxiliary content (i.e. advertisement is displayed during idle time as a screen saver, the screen saver subsystem tracks user interaction with the system and when the screen saver subsystem detects that the system has been idle, for example, when there has been no user interaction with the computer for a preconfigured time, it activates the advertisements display manager which will select an advertisement and display it) (col.3 lines 27-33; col. 7-8 lines 51-3; col. 9 lines 42-49 and col. 12 lines 61-65);

selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of issuance of the request from a client terminal for the auxiliary content and a networked computer accessed by the client terminal ( i.e. the actual list of advertisement categories will be provided by the advertising system server, time periods during which sound only advertisement are to be played, time periods and types of foreground activities during which advertisements and feedback information may be transmitted) (col. 2-3,lines 66-14, col. 3, lines 52-63, col. 7, lines 51-55, col. 9,lines 35-49 and col. 14-15, lines 60-27); and

delivery means in communication with the content selection means for facilitating a download of the selected content to the client terminal over the network (col. 7, lines 45-61, fig. 4).

Claims 2, 5 and 9: Rakavy discloses the method according to claim 4, wherein the broadcast space is segregated into network addresses, the request for auxiliary content includes an address of the networked computer, and the content selection step

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comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and a address of the accessed web site (col. 3, lines 8-43 and col. 5, lines 54-65, fig. 2).

Claims 3, 6 and 10: Rakavy discloses the method according to claim 19, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2 and col. 7-8, lines 63-3).

Claim 12: Rakavy discloses an auxiliary content delivery server comprising:

a content database of records each defining an item of auxiliary content, and a broadcast space for delivery of the associated auxiliary content item, the broadcast space being segregated into time slots (col. 3, lines 4-43 and col. 7- 8, lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col.15, lines 28-42, fig. 10) the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content (i.e. advertisement is displayed during idle time as a screen saver, the screen saver subsystem tracks user interaction with the system and when the screen saver subsystem detects that the system has been idle, for example, when there has been no user interaction with the computer for a preconfigured time, it activates the advertisements display manager which will select an

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advertisement and display it) (col.3 lines 27-33; col. 7-8 lines 51-3; col. 9 lines 42-49 and col. 12 lines 61-65);

content selection means in communication with the content database for selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of issuance of a request from a client terminal for the auxiliary content and a web page accessed by the client terminal (col. 2-3, lines 66-14, col. 3, lines 52-63, col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

receiving means for receiving over a communications network the client terminal request for auxiliary content (col. 3, lines 4-26 and col. 9, lines 17-20); (col. 7, lines 45-61);

delivery means in communication with the content selection means for facilitating a download of the selected content to the client terminal over the network (col. 7, lines 45-61, fig. 4); and

response data processing means for processing response data received from the client terminal in response to the download auxiliary content (col. 5, lines 45-53, fig. 2, col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

claim 13: Rakavy discloses the auxiliary content delivery server according to claim 12, wherein the broadcast space is segregated into network addresses, the request for auxiliary content includes an address of the accessed web page, and the content selection means is configured to select the auxiliary content in accordance with a

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correlation between the broadcast space, and a network address of the accessed web page (col. 3, lines 8-43 and col. 5, lines 54-65, fig. 2).

Claim 14: Rakavy discloses the auxiliary content delivery server according to claim 21, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2 and col. 7-8, lines 63-3).

Claim 15: Rakavy discloses the auxiliary content delivery server according to Claim 12, wherein the response data processing means is configured to maintain statistics associated with the effectiveness of the download auxiliary content based on the received response data (col. 5, lines 54-65, fig. 2).

Claim 18: Rakavy discloses a system in claim 2 above, and further teaches wherein the request for auxiliary content includes an indication of the time instant of the issuance of the request from the client terminal, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space, and the indication of the time instant of issuance of the request (col. 7, lines 51-55, col. 9, lines 47-49 and col. 14-15, lines 60-27).

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claims 19-21: Rakavy discloses a method and a system in claims 5, 9 and 13 above, and further teaches wherein the request for auxiliary content includes an indication of the time instant of the issuance of the request from the client terminal, and the selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and the indication of the time instant of issuance of the request (col. 3, lines 4-43 and col. 7- 8,lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8,lines 51-3 and col.15,lines 28-42, fig. 10).

Claim 22: Rakavy discloses a system in claim 15 above, and further teaches wherein the response data comprises one of a number of times the downloaded auxiliary content was viewed, a duration the downloaded auxiliary content was viewed, a number of users who viewed the selected auxiliary content, and the time slots during which the selected auxiliary content was viewed.

Claim 23: Rakavy discloses a system in claim 22 above, and further teaches wherein the response data identifies the network address of the accessed web site (i.e. internet address are used for communicating on the network with which to communicate) (col. 3, lines 9-43, col. 5, lines 8-30; lines 54-65 and col.6, lines 9-20).

Claim 24: Rakavy discloses a system in claim 23 above, and further teaches wherein the delivery means is configured to provide the client terminal with a network location of



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the selected one auxiliary content item (i.e. a third party may supply a location of a user or advertiser) (col. 9, lines 8-22).

Claims 25 and 27: Rakavy discloses a method and a system in claims 4 and 12 above, and further teaches facilitating a download of the selected one auxiliary content item to the client terminal (i.e. downloading and presenting individual advertisements and other informational messages from a network to a local computer) (col. 2-3 Lines 60-26, col. 5, lines 32-65, col. 6 lines 21-30 and col. 11 lines 31-44); and

receiving from the client terminal response data in response to the downloaded auxiliary content (i.e. the system monitors the user's interaction with the advertisements and produces data on information gathered) (col. 3, lines 44-63, col. 14-15, lines 60-27).

Claim 26: Rakavy discloses a method in claim 25 above, and further teaches further comprising generating a report based on the received response data (i.e. the system monitors the user's interaction with the advertisements and produces data on information gathered) (col. 3, lines 44-63, col. 14-15, lines 60-27).

### ***Response to Arguments***

4. Applicant's arguments filed 05/13/2010 have been fully considered but they are not persuasive.

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5. The Applicant argues that Rakavy does not describe a database of records each defining an item of auxiliary content, and a respective broadcast space for delivery of the associated auxiliary content item, each said broadcast space comprising a respective time slot, the time slot associated with each said auxiliary content item defining a time frame for the delivery of the associated auxiliary content item. The Examiner notes that Rakavy teaches that in one variant of the present invention, all advertisements or other informational messages originate on a network server which is accessed via the internet or alternate on-line method. Select advertisements are transparently downloaded from the network server and stored locally on the user's local computer using a novel type of software referred to herein as a "Polite Agent." In a second variation, the entire advertisement database is locally stored on the local computer or a removable media such as CD-ROM. Manipulation and display of the advertising message is performed by software residing on the PC in accordance with preconfigured user preference information. (col. 3 lines 4-33, col. 7 lines 43-61, col. 9 lines 16-49, col. 10 lines 42-65, col. 11-12 lines 65-4 and col. 12 lines 60-65).

6. The Applicant argues that Rakavy does not describe content selection means in communication with the content database for selecting one of the items of auxiliary content in accordance with a correlation between the broadcast spaces and a time instant of issuance of a request from the client terminal for auxiliary content and a networked computer accessed by the client terminal. The Examiner notes that Rakavy discloses a Polite Agent Technology currently used to download advertisement in the

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background during low line utilization can be **modified** to receive **current data**, such as news and stock quotes (col. 14-15, lines 60-27). Furthermore, an alternate embodiments and modification to the Polite Agent Technology, it is by basic algorithm, able to download and display advertisement at the instant the user requests the content. The actual list of advertisement categories will be provided by the advertising system server, time periods during which sound only advertisement are to be played, time periods and types of foreground activities during which advertisements and feedback information may be transmitted) (col. 2-3, lines 66-14, col. 3, lines 52-63, col. 7, lines 51-55, col. 9, lines 35-49 and col. 14-15, lines 60-27). Finally, in fig. 10 shows a variation of the present invention in which a plurality of Advertisements 50 are stored locally to the Local Computer 500 in a Local Advertisement Database 550 on the Local Storage Device 540 or IAN. The Advertisements feeder 250 selects Advertisements 50 for presentation on the Local Computer 500 from the Local Advertisement Database 550. Selected Advertisements 50 are loaded into the user preference and Advertisement Database 230 for display. (col. 15 lines 28-42).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Himmel et al. (U.S. Patent No. 6,275,854) Method and apparatus for detecting actual viewing of electronic advertising.

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b. Walker et al. (U.S. Pub. No. 2001/0018771) System and method for supplying supplemental information for video programs.

c. Katiyar et al. (U.S. Patent No. 7,366,682) System, method, and code for providing promotions in a network environment.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARILYN MACASIANO whose telephone number is (571)270-5205. The examiner can normally be reached on 5/4/9 8:00-5:30 Mon.-Thur. 8:00-4:30 Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John G. Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. M.  
Examiner, Art Unit 3688  
07/31/2010

/C. Michelle Tarae/  
Primary Examiner, Art Unit 3688